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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,429	11/15/1999	CHRISTOPHER POWER	3045.00004	1631

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EXAMINER

EPPS, JANET L

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/439,429

Applicant(s)

POWER ET AL.

Examiner

Janet L. Epps-Ford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,7,8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,7,8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8, and 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites "A pharmaceutical or medical composition comprising as active ingredient at least one synthetic nuclease resistant antisense oligodeoxynucleotides as set forth in claim 6 in a physiologically acceptable carrier or diluent."

3. Claim 8 recites the limitation " at least one synthetic nuclease resistant antisense oligodeoxynucleotides as set forth in claim 6 " in lines 3-4. There is insufficient antecedent basis for this limitation in the claim since Applicants canceled claim 6.

4. Claims 10-12 recite the limitation "as set forth in claim 5." There is insufficient antecedent basis for this limitation in the claim since Applicants cancelled claim 5.

Response to Arguments

5. Claims 3-4, 7-8, 10 and 13-16 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for inhibiting the expression of TNF-alpha *in vitro*, does not reasonably provide enablement for modulating, which includes for enhancing and inhibiting, the expression of TNF-alpha, *in vivo*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims, for the reasons of record set forth in the Official Action mailed 12-16-02.

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Applicant's arguments filed 3-05-03 have been fully considered, but they are not persuasive. Applicants traverse the instant rejection on the grounds that "in the previously attached paper written by Applicants, there is disclosed that the *in vivo* use of the method as set forth in the present application does perform as indicated in the *in vitro* studies." However, as stated in the prior Office Action, contrary to Applicant's assertions the experimental evidence provided in the cited paper by Applicants utilizes methods that were not disclosed in the specification as filed. Furthermore, Applicants have not provided any information as to when and where the cited paper was published by Applicants. Moreover, if the cited reference was published after the filing date of the present application, the experimental data set forth in the cited reference can not be taken as evidence of enablement since enablement is based upon the guidance given in the specification as filed, and the level of skill in the art at the time filing. Moreover, Applicants argue that the instantly claimed methods and pharmaceutical compositions are enabled based upon data currently attached to Applicant's response filed 3-05-03. However, Applicants make no reference to the specification as filed which supports the data relied upon as evidence of enablement of the specification as originally filed, therefore, unless Applicants submit this data in the form of a properly executed Affidavit/Declaration under 37 CFR 1.312, the newly reference data will not be considered to support Applicant's assertion of enablement of the claimed methods and pharmaceutical compositions.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 703-308-8883. The examiner can normally be reached on M-T, Thurs-Fr, 9AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 703-308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-746-5143 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janet L. Epps-Ford
Examiner
Art Unit 1635

JLE
May 13, 2003



SEAN McGARRY
PRIMARY EXAMINER

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